

PATENT
App. Ser. No.: 09/955,232
Atty. Dkt. No. ROC920010197US1
PS Ref. No.: IBMK10197

REMARKS

This is intended as a full and complete response to the Office Action dated June 23, 2006, having a shortened statutory period for response set to expire on September 23, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-32 are pending in the application. Claims 1-33 remain pending following entry of this response. Claims 1, 11, 12, 19, 21, 27-28, 31-32 have been amended. New claim 33 has been added to recite aspects of the invention. Applicant submits that the amendments and new claims do not introduce new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Simpson et al* (US Pub. 2003/0011801 A1) in view of *Yu* (US Patent 6,707,568 B1). Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejection fails to establish at least the third criteria, as described below. For example, even if combined as suggested in the Office Action, the references fail to teach in response to matching the print file with the stored identification data, transforming the printable content in the print file in accordance with stored print options; whereby the transformed print file produces a printed output different from a printed output that would have been produced by the print file generated by the printer driver, and wherein transforming the printable content comprises removing a portion of

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the printable content in order to avoid printing the removed printable content on the printed output, thereby saving printing resources, as recited in independent claim 1.

Additionally, even if combined as suggested in the Office Action, the references fail to teach transforming the printable content in the print file in accordance with stored print options, whereby the transformed print file produces a printed output different from the printed output that would have been produced by the print file generated by the printer driver, and wherein the printable content that is transformed is selected from at least one of banners, advertisements, solid background, user highlighted content and any combination thereof, as recited in claims 11, 19 and 27.

Applicants respectfully submit that *Yu* does not disclose, teach or suggest removing a portion of the printable content in order to avoid printing the removed printable content on the printed output, thereby saving printing resources, as recited in independent claim 1. Further, *Yu* does not disclose that the printable content that is transformed is selected from at least one of banners, advertisements, solid background, user highlighted content and any combination thereof, as recited in independent claims 11, 19 and 27. In contrast, *Yu* teaches using additional printing resources. *Yu* teaches using additional ink or toner to mask "confidential words and/or clauses". (Column 8, line 14-17 and line 59-62). *Yu* clearly shows, in figure 8C, that certain words are masked, requiring the use of additional printing resources such as ink, toner, electricity and mechanical wear of printer components.

The Examiner argues that *Simpson* discloses transforming printable content that is selected from the group consisting of banners, advertisements, solid background and user highlighted content (paragraph 21 and 23). Applicants respectfully submit, however, that the cited portions are in fact directed at applying print options for specified printers without regard to, and with no transformation of, the printable content (paragraph 21). For example, *Simpson* teaches applying print options such as "duplex or single-sided printing, automatic conversion of a document to the size of paper in the printer (or a particular tray of the printer), automatic stapling of the printed document, the type of stapling (e.g., saddle staple), collation of the printed document, a number of copies of the document to print, a print quality of the document, a particular print media

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source (e.g., a manual input tray on the printer), selection of a watermark, binding options, cutting options, and so forth" (paragraph 21).

Applicants additionally submit that the portions of *Simpson* cited by the Examiner are directed at an "imaging repository" (figure 1, 108), where users may store images, graphics, drawings, frames of video or animations (paragraphs 22-23) and is not directed at transforming printable content selected from the group consisting of banners, advertisements, solid back ground and user highlighted content, as recited in independent claims 1, 11, 19, and 27.

Accordingly, the cited references do not teach or suggest all the claim limitations as asserted by the Examiner. Therefore, independent claims 1, 11, 19 and 27, and their dependents, are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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